

### **REMARKS**

This responds to the Office Action mailed on June 15, 2007.

Claims 1, 4, 13, 25 and 28 are amended, no claims are canceled or added; as a result, claims 1-36 remain pending in this application. The amendments to claims 4 and 28 provide clarification to the claims and are not in response to an art based rejection or other reason related to patentability. The amendments to claims 1, 13 and 25 more particularly describe the claimed inventive subject matter. Support for the amendments may be found throughout the specification, and in particular on page 17, lines 18-29 and on page 18, line 12 to page 22, line 22. Applicant respectfully submits that no new matter has been introduced with the amendments to claims 1, 13 and 25.

### **Interview Summary**

Applicant thanks Examiner **Omkar Deodhar** as well as Supervisory Examiner **John Hotaling**, for the courtesy of a personal interview on **July 25, 2007** with Applicant's representatives **Rodney Lacy and Michael Blankstein**.

Applicant's representative presented new proposed amendments and discussed how the claimed invention distinguishes over Gatto et al. (U.S. 6,916,247). No agreement regarding the status of the claims was reached during the interview. The Examiner indicated that further consideration and a new search would be required regarding the subject matter in the proposed amendments.

### **Specification Objections**

Page 1 of the Specification, under "Cross-reference to Related Applications", was objected to because the serial no. of the Patent Application was not provided. Page 1 has been amended to provide the appropriate serial number. Applicant respectfully requests removal of the objection to the specification.

### Claim Objections

The Examiner objected to claim 1 because the language “registering by the gaming machine...” was considered unclear. The Examiner suggested the claim should be amended to recite, “registering the gaming machine...” Applicant has amended claim 1 substantially as suggested in the Office Action.

The Examiner objected to claims 4 and 28 because the language “issuing by the gaming management service...” was considered unclear. The Examiner suggested the claim should be amended to recite “wherein the gaming management service issues a configuration update to the gaming machine...” Claims 4 and 28 have been amended as suggested in the Office Action.

In view of the amendments to claims 1, 4 and 28, Applicant respectfully requests removal of the objections to the claims.

### Information Disclosure Statement

Applicants submitted an Information Disclosure Statement and a 1449 Form on June 30, 2004. Applicants respectfully request that initialed copies of the 1449 Forms be returned to Applicants' Representative to indicate that the cited references have been considered by the Examiner.

### Double Patenting Rejection

Claims 13-17 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 13-17 of copending Application No. 10/788,902 in view of Gatto (U.S. 6,916,247).

Applicant does not admit that the claims are obvious in view of copending Application No. 10/788,902 and U.S. Patent No. 6,916,247. However, Applicant will consider filing a Terminal Disclaimer in compliance with 37 C.F.R. 1.321(b)(iv) when all other issues related to the patentability of the claims have been resolved.

§102 Rejection of the Claims

Claims 1-36 were rejected under 35 U.S.C. § 102(e) for anticipation by Gatto (U.S. 6,916,247). Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). Applicant respectfully submits that claims 1-36 as amended are not anticipated because the claims contain elements not found in Gatto.

For example, claim 1 recites “sending service information for the gaming management service from the gaming management service to a discovery agent on the gaming network.” Claims 13 and 25 recite similar elements regarding a service sending service information to a discovery agent. Applicant has reviewed Gatto and can find no disclosure of a service sending service information about a gaming management service to a discovery agent on a gaming network.

Further, claim 1 recites “determining by the discovery agent if the gaming management service is authentic and authorized.” Claims 13 and 25 recite similar language with respect to a discovery agent authenticating and authorizing a gaming management service. Applicant has reviewed Gatto and can find no teaching or suggestion of authenticating and authorizing a service such as a gaming management service. Further, there is no disclosure in Gatto of a discovery agent that authenticates and authorizes a gaming management service for a gaming network.

Additionally, claims 1, 13 and 25 as amended recite that the game management service is operable to provide configuration updates to gaming machines on the network. The Office Action stated that a “reasonable interpretation of a ‘management service’, extends to any service that monitors and controls aspects of networked devices.” Applicant respectfully submits that the amendments more particularly define a gaming management service, and further submits that

a gaming management service that provides configuration updates to gaming machines is not disclosed in Gatto.

In view of the above, claims 1, 13 and 25 recite elements that are not taught or suggested by Gatto. Therefore claims 1, 13 and 25 are not anticipated by Gatto. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 1, 13 and 25.

Claims 2-12 depend from claim 1, claims 14-24 depend from claim 13 and claims 26-36 depend from claim 25. These dependent claims inherit the elements of their respective base claims 1, 13 and 25 and are not anticipated by Gatto for at least the reasons discussed above regarding their respective base claims. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 2-12, 14-24 and 26-36.

Additionally, the Office Action asserted that features of claims 9-11, 21-23 and 33-35 were “inherent to the functionality disclosed by Gatto.” Applicant respectfully disagrees because the Office Action has not established a *prima facie* case of inherency because, as recited in MPEP § 2112, “In relying upon the theory of inherency, the examiner must provide basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art,” citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The Office Action merely stated the features were inherent. Thus, the Office Action does not even assert that the allegedly inherent characteristic is necessary, let alone provide a basis in fact and/or technical reasoning.

To serve as an anticipation when a reference is silent about the asserted inherent characteristic, the gap in the reference may be filled with recourse to extrinsic evidence. But, such evidence must make clear that “the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” *Continental Can Co. v. Monsanto Co.*, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). Applicant respectfully submits that the Examiner has not produced extrinsic evidence to show that the element of claims 9-11, 21-23 and 33-35 are necessarily present in Gatto.

**RESERVATION OF RIGHTS**

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art.

**CONCLUSION**

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at (612) 373-6954 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

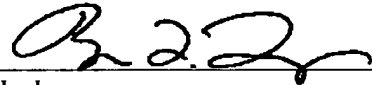
Respectfully submitted,

CHRISTOPHER W. BLACKBURN ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
(612) 373-6954

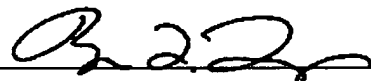
Date September 17, 2007

By   
Rodney L. Lacy  
Reg. No. 41,136

**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 17th day of September 2007.

Rodney L. Lacy

Name

  
Signature